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Paper No. None

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**COPY MAILED**

**JUL 28 2005**

**OFFICE OF PETITIONS**

In re Application of	:	
Hanna Albert Awad	:	
Application No. 09/886,862	:	
Filed: November 20, 2001	:	DECISION DISMISSING
Title: CONCEPTS AND THEIR	:	SECOND RENEWED PETITION
APPLICATIONS, PUMPS, COMPRESSORS	:	UNDER 37 C.F.R. §1.137(a)
WORKING ON VALVES AND ENGINES	:	
WORKING ON THOSE COMPRESSORS	:	

This is a decision on the second renewed petition filed July 11, 2005, pursuant to 37 C.F.R. §1.137(a)<sup>1</sup>, to revive the above-identified application.

The above-identified application became abandoned for failure to file an appeal brief within two months of the submission of the Notice of Appeal. On September 24, 2002, a final Office action was mailed. On February 11, 2003, a Notice of Appeal was received, along with the fee associated with the filing of the Notice of Appeal and a two-month extension of time to make timely this response. No appeal brief was received. Pursuant to 37 C.F.R. §1.192<sup>2</sup>, the failure to

1 A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

- (1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
- (2) the petition fee;
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
- (4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

2 37 CFR 1.192. Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

submit an appeal brief within two months from the date of the notice of appeal will result in the abandonment of the application. Accordingly, the above-identified application became abandoned on April 12, 2003. A Notice of Abandonment was mailed November 28, 2003.

The original petition was submitted on November 1, 2004. On November 17, 2004, a one page statement of facts and an appeal brief were filed. The original petition was dismissed via the mailing of a decision on April 21, 2005, for failure to submit the petition fee.

On May 19, 2005, a renewed petition was submitted, along with the petition fee, a submission which appears to be an appeal brief, and a statement of facts. The renewed petition was dismissed via the mailing of a decision on June 2, 2005. A courtesy copy was re-mailed to Petitioner on July 1, 2005.

With this second renewed petition, Petitioner has set forth "I have sent 10 faxes and three express mails to change my correspondence address nothing has been changed." This is not accurate. As set forth on page 2 of the previous decision: "The Changes of Correspondence Address, submitted on April 26, 2004 and May 3, 2004, were entered and made of record." Furthermore, Petitioner will note that the previous decision was mailed to the same address that appears on both of the requests to change the correspondence address. As such, it is clear that the correspondence address was changed. Perhaps Petitioner placed the wrong address on his requests to change the correspondence address?

With this second renewed petition, Petitioner has also submitted the required response – the \$250 fee associated with the filing of a brief in support of an appeal. As such, Petitioner has met requirements (1) and (2) above. Requirement (4) does not apply.

This second renewed petition under 37 C.F.R. §1.137(a) lacks items (3) however. As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

**The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.**

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."<sup>3</sup>

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable,

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(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

<sup>3</sup> Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."<sup>4</sup>

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"<sup>5</sup>

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."<sup>6</sup>

### The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>7</sup>

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"<sup>8</sup>

Nonawareness of a PTO rule will not constitute unavoidable delay<sup>9</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application<sup>10</sup>.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action<sup>11</sup>.

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<sup>4</sup> Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

<sup>5</sup> Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

<sup>6</sup> Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

<sup>7</sup> Id.

<sup>8</sup> See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>9</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

<sup>10</sup> Id.

<sup>11</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

**The portions of the CFR and MPEP relevant to the abandonment of this application**

37 C.F.R. § § 1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

37 C.F.R. § 1.192 Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

MPEP 1206, Appeal Brief, states, in part:

**TIME FOR FILING APPEAL BRIEF**

37 CFR 1.192(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief. In an ex parte reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274. The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for reply to the action from which the appeal was taken, if such time is later." These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rules, he or she may file a petition, with fee, to the Technology Center (TC), requesting additional time under 37 CFR 1.136(a). Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved under 37 CFR 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

...

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See MPEP § 1215.04. **If there are no allowed claims, the application is abandoned as of the date the brief was due.** (Emphasis added). Claims which have been objected to as dependent from a rejected claim do not stand allowed. In a reexamination proceeding failure to file the brief will result in the issuance of the certificate under 37 CFR 1.570.

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application, as in other cases of abandonment, and to reinstate the appeal; if the appeal is dismissed, but the application is not abandoned, the petition would be to reinstate the claims and the appeal, but a showing equivalent to that in a petition to revive under 37 CFR 1.137 is required. In either event, a proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be in error, filing a petition, pointing out the error, may be sufficient.

A fee under 37 CFR 1.17(c) is required when the brief is filed. 37 CFR 1.192(a) requires the submission of three copies of the appeal brief.

### **Application of the standard to the current facts and circumstances**

The decision on the renewed petition set forth the following:

As indicated in the Final Rejection, mailed on September 24, 2002, claims 1-2 were pending, and claims 1-2 were rejected. No claims were indicated as being allowed. As such, pursuant to 37 C.F.R. §1.192 and MPEP 1206 reproduced above in part, the application became abandoned on April 12, 2003. In both the original and the renewed petitions, Petitioner has alleged that he sent numerous requests to have his correspondence address changed, and that he wished to "continue the patent even with an appeal"<sup>12</sup>. Twenty-one months passed between the filing of the notice of appeal and the submission of the appeal brief. It is not clear how the mailing of a plurality of requests to have his address changed prevented the Petitioner from filing his appeal brief until this time.

With the renewed petition, Petitioner has asserted that a representative with the Patent Assistance center informed him that an appeal brief did not need to be submitted "because they have all the application"<sup>13</sup>. It is not clear when Petitioner alleges this conversation to have taken place – was it before or after his submission of the appeal brief on November 17, 2004? Perhaps the discussion allegedly took place after the submission of the appeal brief, and Petitioner is attempting to convey the message that a duplicate copy of the appeal brief was deemed not to have been necessary because a copy was already received on November 17, 2004? Conversely, if Petitioner is alleging that the conversation took place prior to his submission of the appeal brief, and that he was instructed not to file an appeal brief, Petitioner is reminded that a delay that has been caused by an applicant's reliance upon oral advice from USPTO employees is not unavoidable<sup>14</sup>. Furthermore, as set forth in 37 C.F.R. §1.2, no attention will be paid to any alleged oral understanding in relation to which there is disagreement or doubt.

In conclusion, it is not clear what prevented Petitioner from submitting the appeal brief in a timely manner.

With this second renewed petition, Petitioner has set forth "I did not file the hole appeal because I called the patent assistant before the filing (emphasis added) and they told me "they have the hole application" all you need is an appeal fee."

As set forth in the decision on the renewed petition, in the portion reproduced immediately above, a delay that has been caused by an applicant's reliance upon oral advice from USPTO employees cannot give rise to an unavoidable delay. Furthermore, as set forth in 37 C.F.R. §1.2 reproduced above, no attention will be paid to any alleged oral understanding in relation to which there is disagreement or doubt.

Petitioner has not established that the entire period of delay was unavoidable. Therefore, this renewed petition is **DISMISSED**.

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<sup>12</sup> Original petition, page 6.

<sup>13</sup> Renewed petition, page 3.

<sup>14</sup> *In re Sivertz*, *supra*.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

Petitioner's only relief is a petition under 37 C.F.R. §1.137(b), and - having been made aware of this reality - Petitioner's delay in promptly seeking relief under 37 C.F.R. §1.137(b) may be considered evidence of intentional delay and an absolute bar to revival.

**NOTICE:**

Any request for reconsideration of this decision under 37 C.F.R. §1.137(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Failure to respond will result in abandonment of the application. The request for reconsideration should include a cover letter entitled "Third Renewed Petition under 37 C.F.R. §1.137(a)," and should only address the deficiencies noted in this decision.

**Thereafter, there will be no further reconsideration of this matter**<sup>15</sup>. If, on third renewed petition, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will **not** apply to that decision.

Any response should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail<sup>16</sup>, hand-delivery<sup>17</sup>, or facsimile<sup>18</sup>.



**Paul Shanoski**  
**Senior Attorney**  
**Office of Petitions**  
**United States Patent and Trademark Office**

<sup>15</sup> For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

<sup>16</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>17</sup> Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

<sup>18</sup> (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.